UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,614	12/30/2003	Brian Alan Grove	2043.033US2	9853

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EXAMINER
FADOK, MARK A

ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
05/28/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

	Application No.	Applicant(s)
Office Action Summary	10/749,614	GROVE ET AL.
	Examiner	Art Unit	
	MARK FADOK	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>17 February 2009</u>.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20,26-31,34-53 and 59-78</u> is/are pending in the application.

    4a) Of the above claim(s) <u>3-7,8-20,28,30,31,36-40,42-53,61,63-78</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,2,8,26,27,29,34,35,41,59,60 and 62</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ ~~Notice of Draftsperson's Patent Drawing Review (PTO-948)~~

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2009 has been entered.

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 9/9/2008, which was received 11/10/2008. A species restriction was provided on 1/16/2009 where an election was provided on 2/17/2009 electing group IB including claims 1,2,26,27,34,35,59 and 60 without traverse. It is noted that independent claim 8,29,41 and 66 contains similar subject matter as the other independent claims 1,26,34 and 59 and will therefore be treated in this office action, leaving claims 1,2,8,26,27, 29,34,35,41,59,60 and 62 as open to prosecution in this application.

Interview

The examiner contacted Mr. Bradley Sheer to ask for clarification of what was intended to be claimed. The examiner stated that as understood the applicant's invention provided for a process by which a buyer and seller may share reserve and proxy pricing that is normally secret in order to determine if the buyer or the seller was

willing to move on their position to provide for a sale. The examiner pointed out that

there is not an antecedent basis between the high proxy bid of the determining step and

the proxy bid information of the "in response step". The examiner also stated that there

is nothing being transformed in that there is only a result of information being published.

It was further pointed out that there is no indication of who will be receiving the

information and with whom the information is exchanged.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the

references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Double Patenting

Claims 1-78 of this application conflict with claims 1-32 of Application No.

10/749,625. 37 CFR 1.78(b) provides that when two or more applications filed by the

same applicant contain conflicting claims, elimination of such claims from all but one

application may be required in the absence of good and sufficient reason for their

retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of

demarcation between the applications. See MPEP § 822.

 The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
 Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).
 Claims 1-78 are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-32 of U.S. Patent No. 10/749,614.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because similar recitations such as a reserve price of a proxy bid price being

disseminated after a high proxy bid is identified.

Claim Rejections - 35 USC § 101

 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claims 59 and 66 are directed to non-statutory subject matter. Based on Supreme Court precedence see Diamond v Diehr 450 US 175,184 (1981); Parker v. Flook, 437 US 584,588,n. 9 (1978); Gottschalk v Benson, 409 US 63, 70 (1972); Cochtane v Deener, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject mater (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

Claims 1,2,8,26,27, 29,34,35,41,59,60 and 62 are rejected because the claims are directed solely to a mathematical algorithm where the overall concept is merely an abstraction. Further the machine or transformation must impose meaningful limits on the claims scope. Adding an insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. In this case simply publishing or storing the result of the determining step is considered an insignificant step. The examiner is looking for some meaningful transformation such as for example the system using the data to lower the reserve price or raising the high proxy bid price.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,8,26,27, 29,34,35,41,59,60 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unable to ascertain the association between the proxy bid and reserve price and the information that is being exchanged or published. i.e. a determination is made in regards to some particular data sets and then random data concerning a proxy bid information and a reserve price information is then published. There is no correlation between the published data and the determining step.

Claims 26 and 29 are rejected because they try to claim a signal. A signal as used in the claim is not patentable subject matter, see In Re Nuitjen, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007) and MPEP 2106. These claims indicate that there are means for accomplishing the tasks. The specification indicated that a machine readable medium may contain a signal. The specification does not specifically state that in all embodiments that the medium is executed on a process therefore the means statements may be software per se.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1,2,8,26,27, 29,34,35,41,59,60 and 62 are rejected under 35

U.S.C. 102(e) as being anticipated by Churchill (US 7461022).

In regards to claim 1, Churchill discloses a computer-implemented system

comprising:

a processor coupled to a memory through a bus; and

an auction price-setting process executed from the memory by the processor to

determine that a high proxy bid is less than a reserve price and,

in response, cause the processor to automatically publish at least one of a proxy

bid information and

the reserve price, the proxy bid information and the reserve price being

associated with a listing for an item during an auction price-setting process (FIG 9 and

10, Bid or Buy Auction and Automated Bidder/High proxy Bid).

In regards to claim 2, Churchill teaches a wherein the auction price-setting process further causes the processor to automatically retract publication of the proxy bid information upon the high proxy bid exceeding the reserve price (FIG 9 and 10, high proxy bids and regular bids that did not originally surpass reserve price are published and revaluated for receiving a sold indication when the reserve price is lowered. Publication is not made of any of the bids that exceeded the current or past published reserve price, therefore proxy bids that exceed the reserve are not published since only those bids that did not exceed the posted reserve price are reconsidered for the reduced reserve price).

In regards to claim 8, Churchill discloses a computer-implemented system comprising:

a processor coupled to a memory through a bus; and

an auction price-setting process executed from the memory by the processor to determine that a high proxy bid is less than a reserve price and,

in response, cause the processor to exchange of at least one of a proxy bid information of a buyer and a reserve price information of a seller,

the at least one of the proxy bid information and the reserve price information being associated with a listing utilizing the auction price-setting process (see response to claim 1).

In regards to claim 26, Churchill discloses a computer-implemented system comprising:

a means for determining that a high proxy bid is less than a reserve price and,

in response to the determining, automatically publishing at least one of a proxy bid information and the reserve price, the proxy bid information and the reserve price being associated with a listing for an item in an auction price-setting process; and

a storage means, coupled to the means for automatically publishing, for storing the proxy bid information and the reserve price (see response to claim 1).

In regards to claim 27, Churchill teaches a means for automatically retracting publication of the at least one of the proxy bid information upon the high proxy bid exceeding the reserve price,

the means for retracting coupled to the storage means (see response to claim 1).

In regards to claim 29, Churchill discloses a means for exchanging of proxy information of a buyer and reserve price information of a seller,

the proxy information and the reserve price information being associated with a listing of an item utilizing an auction price-setting process; and

a storage means, coupled to the means for exchanging, for storing the proxy information (see response to claim 1).

In regards to claim 34, Churchill discloses a determining that a high proxy bid is less than a reserve price and,

in response to the determining, automatically publishing at least one of a proxy bid information and the reserve price, the proxy bid information and the reserve price being associated with a listing for an item during an auction price-setting process (see response to claim 1).

In regards to claim 35, Churchill teaches a which when executed by one or more processors, perform the following operation:

automatically retracting publication of the proxy bid information upon the high proxy bid exceeding the reserve price (see response to claim 2).

In regards to claim 42, Churchill discloses a exchanging of proxy information of a buyer and reserve price information of a seller,

the proxy information and the reserve price information being associated with a listing utilizing the auction price-setting process (see response to claim 1).

In regards to claim 59, Churchill discloses a determining that a high proxy bid is less than a reserve price and,

in response to the determining, automatically publishing at least one of a proxy bid information and the reserve price, the proxy bid information and the reserve price

being associated with a listing for an auction price-setting process (see response to claim 1).

In regards to claim 60, Churchill teaches a automatically retracting publication of the proxy bid information upon the high proxy bid exceeding the reserve price (see response to claim 2).

In regards to claim 1, Churchill teaches a wherein the publication is performed during the auction price-setting process (see response to claim 1).

Response to Arguments

Applicant's arguments with respect to claims 1,2,8,26,27, 29,34,35,41,59,60 and 62 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300   [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/
Primary Examiner, Art Unit 3625